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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,239	05/07/2004	Timothy L. Robinson	129510.11801	7593

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PEPPER HAMILTON LLP
ONE MELLON CENTER, 50TH FLOOR
500 GRANT STREET
PITTSBURGH, PA 15219

EXAMINER	
ROSARIO, DENNIS	
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2624	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/840,239	ROBINSON ET AL.	
	Examiner	Art Unit	
	Dennis Rosario	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,10,12-18,21-26,28-32,34 and 35* is/are pending in the application.

4a) Of the above claim(s) *16-18,21-26 and 28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,9,10,12-15,31,32,34 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment was received on 2/25/08. Claims 1,4,5,10,12-18,21-26,28-32,34 and 35 are pending. Claims 36-54 are withdrawn. Claims 2,3,6-8,11,19,20,27,33 are canceled.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1,4,5,9,10,12-15,31,32,34 and 35, drawn to quality of a device, classified in class 455, subclass 452.2.

II. Claims 16-18,21-26 and 28-30, drawn to quality of data, classified in class 702, subclass 69.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as quality of a channel's bandwidth. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Joseph T. Helmsen, Reg. No.: 54,163 on 5/15/08 a provisional election was made with traverse to prosecute the invention of Group I, claims 1,4,5,9,10,12-15 and 31-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-18,21-26 and 28-30 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Arguments

6. Applicant's arguments, see page 11 with respect to Hillhouse, filed 2/25/08, with respect to 102(e) have been fully considered and are persuasive. The rejection of claims 1,3-5,7-18 and 29 has been withdrawn.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "quality of biometric data" on page 11, last paragraph and "quality of an image" on page 12 with respect to Kyle and "evaluating the quality of biometric data" on page 15, 3rd paragraph) are not recited in the rejected claims 1 and 31. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant's arguments with respect to claim 1 in view of Sukegawa and Kyle have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments, see page 15, 1st paragraph, filed 2/25/08, with respect to 102 (e) in view of Sukegawa have been fully considered and are persuasive. The rejection of claims 31,32,34 and 35 has been withdrawn.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1,4,5,9,10,12-15,31,32,34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Bianco et al. (US Patent 6,256,737 B1).

Regarding claim 1, Bianco discloses a method in a biometric authorization system, the method comprising:

a) receiving (as done by fig. 1, num. 106), from a first biometric device (fig. 1, num. 110), biometric data (corresponding to fig. 5, numerals 502-508) that is based on biometric information that is taken from a user (as fig. 5, num. 510 implies);

b) locating (via fig. 1, num. 106 that locates data in any of fig. 1, numerals 104,110 and 108) a user record (as implied in fig. 1, num. 106 since 106 enrolls users) associated with said user (for enrollment or re-enrollment purposes);

c) generating (via fig. 1, num. 106) upgraded biometric data (corresponding to a re-enrollment procedure or already enrolled users) based on a combination of biometric data (of fig. 5, num. 506 which is a combination of users' biometric data) associated (broadly) with said user record (fig. 5, num. 510) received from a second biometric device (fig. 1, num. 104) and said received biometric data (corresponding to fig. 5, numerals 502-508 that is stored in fig. 1, num. 110) if the first biometric device (fig. 1, num. 110) is of a higher quality (since 110 backs up 104 in the event of data loss due to 104 failing as discussed in col. 10, lines 31-33) than the second biometric device (fig. 1, num. 104); and

d) storing the upgraded biometric data (from a re-enrollment procedure) in said user record (that is stored in fig. 1, num. 110 in the event of data loss).

Regarding claim 4, Bianco discloses the method of claim 1, further comprising:

a) prompting said user for one or more additional biometric samples (corresponding to fig. 8B, num. 826) to employ (in the event of said data loss) for said generating upgraded biometric data.

Regarding claim 5, Bianco discloses the method of claim 1, further comprising:

a) generating a biometric template (fig. 5, num. 502) from said received biometric data.

Regarding claim 9, Bianco discloses the method of claim 1, further comprising:

a) receiving (as done by fig. 5, num. 104) a user identification code (from fig. 5, num. 510).

Regarding claim 10, Bianco discloses the method of claim 1, wherein said upgrading generating upgraded biometric data is initiated by a third party system (or said fig. 1, num. 110 that upgrades biometric data in the event of a data loss of fig. 1, num. 104).

Regarding claim 12, Bianco discloses the method of claim 1, wherein said storing is determined by the system (as indicated by the flowchart in fig. 6:622).

Regarding claim 13, Bianco discloses the method of claim 1, wherein said storing comprises:

a) storing a plurality of biometric data upgrade transactions (corresponding to fig. 6:622:BIOMETRIC TEMPLATES that can be upgraded).

Regarding claim 14, Bianco discloses the method of claim 1, further comprising:

a) comparing (using fig. 1, num. 106), at a local biometric device (relative to fig. 1, num. 112), said received biometric data or a biometric template based on said received biometric data with said biometric data associated with said user record.

Regarding claim 15, Bianco discloses the method of claim 1, further comprising:

comparing (using fig. 1, num. 106), at a central database (fig. 1, num. 108 which is local to fig. 1, num. 106 as compared to fig. 1, num. 112), said received biometric data or a biometric template based on said received biometric data with said biometric data associated with said user record.

Regarding claim 31, Bianco discloses a method in a biometric authorization system, the method comprising:

a) receiving, at a database (fig. 1, num. 110 or fig. 1, num. 108), biometric data (from fig. 7, num. 722) that is based on biometric information taken from a user (represented in fig. 7 an num. 208) at a local biometric device (relative to fig. 1, num. 112);

b) locating (via fig. 1, num. 106), at said database (fig. 1, num. 110 or 108), a user record (fig. 5, num. 510) associated with said user;

c) authorizing said user at said database (via fig. 7, num. 704), said authorization being based on a comparison (represented in fig. 7 as num. 712) using said received biometric data (from fig. 1, num. 110) and second biometric data (fig. 1, num. 104) that is associated with said located user record (fig. 5, num. 510);

c) determining (via fig. 1, num. 110 or fig. 1, num. 108) whether said received biometric data (stored in fig. 1, num. 110) is useful to upgrade (in the event of data loss) said second biometric data (stored in fig. 1, num. 104), wherein said determining is based on a quality (or storage integrity) of said local biometric device (fig. 1, num. 104 that is a local device relative to fig. 1, num. 112);

d) upgrading (or recovering from the data loss to become "active again" in col. 10, lines 47,48 or "updates" in col. 10, lines 52,53 databases 104 and 110) said second biometric data (fig. 1, num. 104) associated with said user record using said received biometric data (fig. 1, num. 110 or 108), if it is determined that said received biometric data (stored in fig. 1, num. 110 or 108) is useful (in the event of data loss of 104) to upgrade said second biometric data (fig. 1, num. 104); and

e) storing (via fig. 1, num. 104) the upgraded biometric data (after recovery or update of fig. 1, num. 104) in association with said user record.

Claim 32 is rejected the same as claim 9. Thus, argument similar to that presented above for claim 9 is equally applicable to claim 32.

Regarding claim 34, Bianco discloses the method of claim 31, wherein said determining comprises:

a) determining whether said received biometric data (of fig. 1, numerals 108 and 110) can augment previously registered biometric data (during a check of data loss of fig. 1, num. 104).

Regarding claim 35, Bianco discloses the method of claim 31, wherein said determination is based on an age (or "file date" in col. 51, lines 40-43) of previously registered biometric data.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kitson et al. (US Patent 6,937,135) is pertinent as teaching a method of a sensor of low quality and high quality and an biometric image with low and high quality.

Brooks (US Patent 6,898,299) is pertinent as teaching a method of updating a database of signatures.

Prokoski et al. (US Patent 6,850,147) is pertinent as teaching a method of a user upgrading, maintaining and repairing a biometric device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Rosario/
Examiner, Art Unit 2624

/Matthew C Bella/
Supervisory Patent Examiner, Art Unit 2624